

Atty. Docket No. KOV-012

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Christopher GUDEMAN et al.

APPLICATION NO: 10/749,876

FILED: DECEMBER 31, 2003

FOR: RADIATION PATTERNABLE
FUNCTIONAL MATERIALS,
METHODS OF THEIR USE, AND
STRUCTURES FORMED
THEREFROM

:

: GROUP ART UNIT: 1752

:

: EXAMINER: WALKE, Amanda C.

I hereby certify that this document is being facsimile transmitted to the USPTO or deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 12, 2005.

By: _____
Jennie Heaton

PETITION TO WITHDRAW RESTRICTION REQUIREMENT UNDER 37 C.F.R.

1.181

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SIR:

In the interests of justice, Applicant's undersigned representative respectfully requests withdrawal of the Restriction Requirement dated April 20, 2005 in the above-identified application. Additional facts are as follows:

1. On April 20, 2005, restriction was required in the above-identified application as follows:

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Group I: Claims 1-20, drawn to a radiation patternable functional material;

Group II: Claims 21-37, drawn to a compound;

Group III: Claims 38-63, drawn to a radiation definable ink;

Group IV: Claims 64-73, drawn to a method of making a radiation patternable functional material;

Group V: Claims 74-91, drawn to a method of making a compound;

Group VI: Claims 92-112, drawn to a method of making an electronically functional thin film; and

Group VII: Claims 113-123, drawn to a thin film structure.

2. A copy of the Restriction Requirement dated April 20, 2005 is attached as Exhibit A.

3. On May 18, 2005, Applicants elected, with traverse, Group I, Claims 1-20, drawn to a radiation patternable functional material. At the same time, Applicants canceled Claims 113-123, the claims of Group VII.

4. A copy of Applicants' Restriction Response dated May 18, 2005 is attached as Exhibit B.

5. In the Amendment filed concurrently herewith in the above-identified application, Applicants have amended the claims so that every pending claim depends, directly or indirectly, from Claim 1. A copy of the claims as amended by the Amendment filed concurrently herewith is attached to this Petition as Exhibit C.

6. M.P.E.P. § 803 states that restriction is proper only when the groups of claims are (A) independent or distinct as claimed, and (B) there is a serious burden on the Examiner, and that Examiners must provide reasons and/or examples in support of their conclusions.

7. M.P.E.P. § 802.01 states that claims are independent when there is no disclosed relationship between them; for example, a process and an apparatus that is *incapable* of being

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used in practicing the process (emphasis added). M.P.E.P. § 802.01 further states that claims are distinct when they are related as disclosed, but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original).

8. By virtue of every claim in the above-identified application depending directly or indirectly from Claim 1, there are no claims in the above-identified application that can be independent from the other claims, as that term is defined by M.P.E.P. § 802.01.

9. In the restriction requirement dated April 20, 2005, the relationship between many of the groups was mischaracterized (e.g., Groups I and II, Groups I and III, Groups I and IV, Groups I and V, Groups I and VI, Groups II and III, Groups II and IV, Groups II and VI, Groups III and IV, Groups III and V, Groups IV and V, Groups IV and VI, Groups V and VI).

10. For example, in the restriction requirement dated April 20, 2005, the claims of Groups I and II were considered unrelated, because the compound was not believed to be required to be employed in a radiation sensitive material, and the radiation sensitive material was not believed to require the specifically claimed compound.

11. However, Claim 1 (Group I) is drawn to a radiation patternable functional material, comprising ligands containing a photoreactive group or a group that is reactive with a photochemically generated species and that, after first-order photoreaction or reacting with said photochemically generated species, materially changes the solubility characteristics of said material in a developer. Furthermore, Claim 21 (Group II) is not only drawn to a compound containing a group that is photoreactive or that is reactive with a photochemically generated species and which, after first-order photoreaction or reacting with said photochemically generated species, materially changes the solubility characteristics of said compound in a developer, but it also depends from Claim 1.

12. Thus, the claims of Group II are related to the claims of Group I.

13. In addition, the restriction requirement dated April 20, 2005 states that Groups I and III are distinct because, in the Examiner's opinion, the ink could be made employing a

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different photosensitive material and/or the material of Group I is not required to be employed in an ink.

14. However, Claim 38 (Group III) is (and always has been) drawn to a radiation definable ink, comprising the material of Claim 1 (Group I). Based on the language of claim 38, it is not known how the ink of Group III could be made employing a photosensitive material other than the material of Claim 1 (Group I).

15. Furthermore, it is not known how the ink of Group III could be capable of separate manufacture, use or sale from the material of Claim 1, as the ink of Group III is required to include the material of Claim 1.

16. Thus, the relationship between Groups I and III was mischaracterized in the restriction requirement dated April 20, 2005.

17. The restriction requirement dated April 20, 2005 states that Groups I and IV are distinct, because the process (of Group IV) is generic and could be employed to prepare many other materials having different compositions than that of Group I.

18. However, Claim 64 (Group IV) is drawn to a "method of making the material of Claim 1" (Group I). Based on the language of Claim 64, it is not known how the method of Group IV could be used to make a material having a composition that differs from that of Claim 1 (Group I).

19. Thus, the claims of Group IV are related to the claims of Group I.

20. The restriction requirement dated April 20, 2005 states that Groups I and V are unrelated because, in the Examiner's opinion, the groups are quite different and there is no relation between the radiation sensitive material of Group I and the method of making a compound of Group V.

21. In this case, the conclusion of unrelatedness has been merely restated as a reason and/or example in support of finding the same.

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22. In addition, Claim 74 (Group V) is drawn to a "method of making the compound of Claim 21" (Group II). As explained above, Claim 21 (Group II) is not only drawn to a compound containing a group that is photoreactive or that is reactive with a photochemically generated species and which, after first-order photoreaction or reacting with said photochemically generated species, materially changes the solubility characteristics of said compound in a developer, Claim 21 also depends from Claim 1 (Group I).

23. Thus, the claims of Group V are related to the claims of Group I.

24. The restriction requirement dated April 20, 2005 states that Groups I and VI are unrelated, because the material may be coated onto a substrate and used to form a pattern in and of itself.

25. However, Claim 92 (Group VI) is drawn to a method of making an electronically functional thin film, comprising irradiating the ink of Claim 38 (Group III). As explained above, Claim 38 is drawn to a radiation definable ink, comprising the material of Claim 1 (Group I). Thus, Claim 92 depends indirectly from Claim 1.

26. Thus, the claims of Group VI are related to the claims of Group I.

27. The restriction requirement dated April 20, 2005 states that Groups II and III are unrelated because, in the Examiner's opinion, the groups are drawn to two distinct inventions, the compound of Group II is not required to be used in the [printing] ink, nor does the [printing] ink (presumably of Group III) require the use of the compound.

28. However, Claim 38 (Group III) is drawn to a radiation definable ink (rather than a printing ink), comprising the material of Claim 1 (Group I). As explained above, Claim 21 (Group II) also depends from Claim 1 (Group I).

29. Thus, the claims of Group III are related to the claims of Group II.

30. Furthermore, by the principle of claim differentiation, the limitations of one dependent claim are not necessarily required to be used in another dependent claim, and vice versa.

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31. If the reasons and/or examples set forth in the restriction requirement dated April 20, 2005 in support of restriction between Groups II and III are plausible and/or legally sufficient, then the USPTO can require restriction between any two claims that depend from the same independent claim. However, the USPTO frequently issues patents containing such dependent claims. Applicants' undersigned representative estimates that millions of such patents have issued from the USPTO since the origination of dependent claims.

32. Thus, restriction between the claims of Groups II and III is improper, and should be withdrawn.

33. Furthermore, largely for the reasons discussed above with regard to Groups I and II, Groups I and III, Groups I and IV, Groups I and V, Groups I and VI, and Groups II and III, the reasons and/or examples provided in the Restriction Requirement dated April 20, 2005 in support of the conclusions of unrelatedness between Groups II and IV, Groups II and V, Groups II and VI, Groups III and IV, Groups III and V, Groups III and VI, Groups IV and V, Groups IV and VI, and Groups V and VI are technically and factually inaccurate, and/or logically and legally inadequate.

34. In the interest of saving the Office's time, Applicants' undersigned representative wishes to state simply that all claims in the present application depend directly or indirectly from Claim 1, and therefore, the various Groups of claims in this application cannot be independent from one another. Applicants' undersigned representative wishes to refer the Office of Petitions to the Restriction Response filed on May 18, 2005 for detailed explanations as to why the reasons and/or examples provided in the Restriction Requirement dated April 20, 2005 in support of the conclusions of unrelatedness between Groups II and IV, Groups II and V, Groups II and VI, Groups III and IV, Groups III and V, Groups III and VI, Groups IV and V, Groups IV and VI, and Groups V and VI are technically and factually inaccurate, and/or logically and legally inadequate.

35. Fees under 37 C.F.R. 1.17(m) for filing this Petition, under 37 C.F.R. 1.18(a) for the Issue Fee, and under 37 C.F.R. 1.18(d) for the Publication Fee are submitted herewith.

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36. Consequently, in the interest of justice, Applicant's undersigned representative respectfully requests withdrawal of restriction requirement in the above-identified application as to Groups I-VI, identified in paragraph 1 above.

37. Additional facts in support of this Petition may be provided on request.

38. Further, Petitioner sayeth not.

Early notice of any decision by the U.S. Patent and Trademark Office to grant the relief requested in paragraph 12 above is respectfully requested.

Respectfully submitted,

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